

REMARKS

Non-elected claims 22-26 have been canceled. Independent claim 12 has been amended. Claim 13 has been amended to include all of the limitations of canceled claim 12.

In ¶ 3 (page 2) of the office action, claims 1-10 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In response to this ground of rejection, the limitation "pivotably coupled" has been deleted from claim 1. In view of the deletion of the offending limitation, the Applicant submits that the enablement ground of rejection is now moot.

In ¶ 5 (page 4) of the office action, claim 12 was rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,382,100 to Satoh et al. In view of the cancellation of claim 12, the Applicant submits that this ground of rejection is now moot.

On page 3 of the office action, claims 1-11, 13-21 and 27-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh et al. in view of U.S. Patent No. 5,573,629 to Rock et al. The Applicant traverses this ground

Atty. Docket: ITW-14146

of rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met by the Examiner, as set forth at MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the combined prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. The Applicant demonstrates below that neither the motivation criterion nor the expectation of success criterion has been met in the Office Action, and that the rejection based on Sato in combination with Rock should be withdrawn.

As stated in the first sentence of the Sato patent: "This invention relates to a roller construction for noncontact guiding of an elongate strip of pliant material, and particularly to such a roller construction capable of pneumatically guiding a web of paper in a rotary printing press without contacting, and so without smearing, the printed

Atty. Docket: ITW-14146

surface or surfaces of the web." [Satoh, col. 1, lines 5-10; emphases added.] Figures 2 and 3 of Satoh show a roller 3 having a multiplicity of air outlet openings 33 formed all over its surface. "[A]ir is expelled under pressure from all these openings against the web W traveling around the roller 3, causing the web to fly over the roller as pictured in FIG. 2." [Satoh, col. 7, lines 35-38.] In addition, a baffle 41 is provided for redirecting air into the web-roller gaps with flow rates that are adjustable "to assure optimal web flight, unflattering and contact-free, over the roller 3." [Satoh, col. 1, lines 5-10; emphases added.] As stated in column 10 (lines 17-23):

As the webs W travel past the roller assemblies 2a and 2b, these roller assemblies will emit the heated and the cooled air, respectively, from the outlet openings 33 in the rollers 3. Part of the air thus flowing out the openings 33 will be applied directly to the webs W, creating a plenum layer between webs and rollers and thereby holding the webs out of contact with the rollers.

[Emphasis added.] Thus the Satoh invention is directed to a pneumatic roller that is designed to prevent the paper web from contacting the roller.

In contrast, the Examiner has cited the Rock patent for the teaching of "a nip assembly as shown in the figures with the roller having a resilient or rubber cover (col. 6

Atty. Docket: ITW-14146

lines 10+)." The Examiner further states: "Rock et al. show hard roller means 78 (col 5 lines 65+) working in combination with roller means 76 to form a nip." As seen in Figure 8 of Rock, the hollow resilient cover 86 of the pneumatic roller 76 deforms to distribute a pressing force across the workpiece. Thus the pneumatic roller 76 of Rock is designed to contact the workpiece - which is the exact opposite of the function of the pneumatic roller of Satoh, namely, to prevent the paper web from contacting the roller.

Accordingly, the Examiner's statement that: "It would have been obvious to provide Satoh et al. with nip means and resilient means as taught by Rock . . ." flies in the face of the facts as plainly stated in the Satoh and Rock patents. It would not be obvious to substitute a deformable pneumatic roller designed to contact the workpiece, as taught by Rock, for a pneumatic roller designed to not contact the workpiece, as taught by Satoh. To do so would render the Satoh system inoperative and frustrate the explicit purpose of the Satoh teaching.

The governing rules, set forth in Section 2143.01 of the MPEP, are as follows: "If [the] proposed modification would render the prior art invention being modified unsatisfactory

Atty. Docket: ITW-14146

for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). . . . If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

As the Applicant has already argued, the proposed combination of Satoh with Rock violates both rules cited in the preceding paragraph. The pneumatic roller of Satoh is designed to prevent contact between the roller and the workpiece. If the deformable pneumatic roller of Rock were substituted for the pneumatic roller in the Satoh system, then the Satoh would be unsuitable for its intended purpose, namely, preventing the printed surface of the paper web from coming into contact with the roller. This would also change the principle of operation of the Satoh teaching. Accordingly, the Applicant respectfully requests that the obviousness rejection based on the combination of Satoh and Rock be withdrawn.

In view of the foregoing, the Applicant submits that this application is now in condition for allowance.

Atty. Docket: ITW-14146

Reconsideration of the application and allowance of claims 1-11, 13-21 and 27-32 are hereby requested.

Respectfully submitted,

June 14, 2005
Date

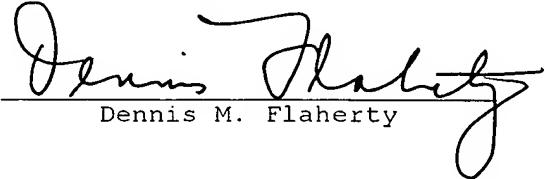


Dennis M. Flaherty
Reg. No. 31,159
Ostrager Chong Flaherty &
Broitman P.C.
250 Park Avenue, Suite 825
New York, NY 10177-0899
Tel. No.: 212-681-0600

CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

June 14, 2005
Date


Dennis M. Flaherty